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| PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 00-033	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature_____	Application Number 09/679,186	Filed October 3, 2000
	First Named Inventor Jay S. Walker	
Typed or printed name _____	Art Unit 3714	Examiner Travis R. Banta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
      Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.   33,384
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____
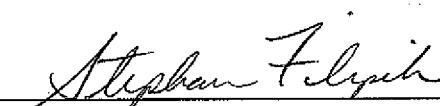
Signature
Stephan J. Filipek
Typed or printed name

203-461-7252
Telephone number

September 7, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒ *Total of _____1_____ forms are submitted.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Application No.: **09/679,186**   Customer No. **22927**

Examiner: **BANTA, Travis R.**   Confirmation No.   **7415**

REMARKS AND ARGUMENTS

Applicants respectfully request Pre-Appeal Brief Review of the rejections contained in the Final Office Action mailed April 9, 2007 (the "Final Action"). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

A.   Status of Claims

Claims **40-74** are pending, and claims **40, 69, 70, 73 and 74** are independent.

Claims **40, 69, 70, 73 and 74** stand rejected under 35 U.S.C. § 112, first paragraph, and claims **40-74** stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneier et al., U.S. Patent No. 5,871,398 (hereinafter "Schneier") in view of Nguyen, U.S. Patent No. 6,857,959 (hereinafter "Nguyen").

B.   Claim Rejection Under 35 U.S.C. § 112, First Paragraph

Independent claims **40, 69, 70, 73 and 74** stand rejected as failing to comply with the written description requirement.

The PTO's policy manual recites that the Examiner bears the burden of establishing a *prima facie* case of unpatentability for a Section 112, first paragraph, rejection (See MPEP 2163 (II)(A)). Evidence and reasoning must be provided to explain, by a preponderance of the evidence, why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See In re Wertheim, 541 F.2d at 263, 191 USPQ at 97 (CCPA 1976). "The description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 169 USPQ 367, 370, 439 F.2d 220, 224 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description." MPEP 2163 (III) (A). Thus, the proper inquiry is whether the specification

describes the claimed invention in sufficient detail so that one skilled in the art can reasonably

conclude that the inventor had possession of the claimed invention. Appellants recognize that:

"New or amended claims which introduce elements or limitations which are not supported by the

as-filed disclosure violate the written description requirement." MPEP 2163(I)(B)

In support of the Section 112, first paragraph, rejection, the Examiner asserts:

> "...The amendment to these claims states "receiving from the player an
> indication, after receiving the total payout amount information...". The
> specification teaches in many places that embodiments have been conceived of
> that allow the device to receive a player selection of an item before the total
> payout amount is received (see page 3 lines 20-23, 30-33, page 4 lines 3-7, 8-11,
> 16-20, 21-24, page 5 lines 4-7, 8-12, page 8 lines 18-26, page 10 lines 24-32 in
> reference to Figure 1). The example provided in page 13 of the specification
> shows an example of a player device receiving a total game outcome amount
> unbeknownst to the player prior to the player's indication of a preferred item.
> Total payout amount as defined in the specification on page 8 lines 4-5 is defined
> as "the total money a player wins with respect to a total number of events". The
> claims have been examined using this definition of "total payout amount". The
> total payout amount is necessarily not received until at least after the player has
> made a selection because the player must make a selection of a preferred item
> before a decision of a win or a loss is made by the machine. For example, a player
> buys 5 tickets with determined outcomes $0, $2, $6, $0 and $0. The player
> selects a book worth $10. After the selection is made, the machine or merchant
> will decide whether $10 is sufficient for the purchase of the book. It may or may
> not be. If it is, the total payout amount is the $10 book. If it is not, the total
> payout amount is $0 or $8 depending on the embodiment. It is therefore
> impossible to determine a total payout amount before a player makes a selection
> of a preferred item according to the disclosure because the total payout amount
> (or value of the win) is unknown until the player makes a selection." (Final
> Action, pages 2-3)

The Examiner apparently believes that claims **40, 69, 70, 73 and 74** do not enable one

skilled in the art to determine the steps needed to arrive at the invention because "it is impossible

to determine a total payout amount before the player makes a selection". This statement is

incorrect. The present specification does not prohibit a merchant from first receiving

information regarding a total payout amount before a player indicates an item that the player

wishes to win. While it is true that the cited example appearing on page 13, line 18 to page 14,

line 10 describes an embodiment wherein a player indicates an item she wishes to win before the

merchant accesses her PC to determine if her lottery outcomes are adequate, other embodiments

are described. In particular, an embodiment is disclosed wherein a merchant receives an indication that an item should be provided to a player based on information associated with the item and an outcome associated with a game event (see page 4, lines 29-31). There is no prohibition on the order in which the outcome and item information is received. Therefore, the outcome data may be received <u>before</u> the item information. In addition, the specification recites that the disclosed methods can be practiced in any order practicable, and performed by any described device (see page 30, lines 9-12). Accordingly, in some embodiments, one skilled in the art would understand that a merchant device could receive a total payout amount from a player device <u>before</u> receiving an indication of an item that the player wishes to win.

In view of the above remarks, Appellants respectfully assert that the specification as filed conveys with reasonable clarity that the applicants were in possession of the claimed invention as of the filing date of the application, which is the proper inquiry to be satisfied. Accordingly, the Examiner has <u>not</u> established a *prima facie* case of unpatentability, and thus we submit that the rejection of claims **40, 69, 70, 73 and 74** under 35 U.S.C. §112, first paragraph, cannot stand.

C.   <u>Claim Rejections Under 35 U.S.C. §103(a)</u>

Claims **40-74** stand rejected as being unpatentable over <u>Schneier</u> in view of <u>Nguyen</u>.

<u>Schneier</u> teaches a remote lottery system that enables players to purchase instant-type lottery game outcomes from a randomized prize data stream in a central computer, and view the outcomes on a gaming computer that does not require an on-line connection during play (see <u>Schneier,</u> Abstract, and col. 5, line 55 to col. 6, line 20). The Examiner admits that <u>Schneier</u> does not teach receiving an indication from the player of an item that the player is interested in winning, nor determining a value of the item, nor arranging for the player to receive the item (page 4 of the <u>Final Action</u>). Moreover, <u>Schneier</u> does not disclose receiving the indication of the item that the player is interested in winning *after receiving total payout amount information* that has <u>not</u> been disclosed to the player, as required by each of claims **40, 69, 70, 73 and 74**.

<u>Nguyen</u> discloses methods and gaming machines having a memory storing a list of prizes, a prize display, and a prize selection mechanism for a player to select a prize specific to one or more outcomes (<u>Nguyen,</u> col. 3, lines 28-35). The prize selection process begins <u>before</u> game play (and before any game outcome), such that the player "plays for the selected prize"

(for example, see the "name your prize" embodiment; col. 15, lines 3-24 and Fig. 7). Thus, the player selects one or more prizes connected to one or more possible game outcomes <u>before initiating game play</u> (see, for example, col. 4, lines 26-36; col. 7, lines 30-37; and col. 12, lines 8-11). One or more prizes are chosen, and the prize information could be stored on a magnetic card readable by a card reader. To start game play, the player inserts the magnetic card into a card reader, which reads the prize information and selects an appropriate pay table. The gaming machine then presents game outcomes, and if a specific game outcome corresponds to a selected prize payout, then the player wins his selected prize (col. 11, lines 27-61).

C.1.   <u>Nguyen Teaches Away from the Present Claims</u>

<u>Nguyen's</u> system provides game outcomes **after** the player selects a prize or prizes to be awarded, which <u>teaches away</u> from the method of the pending claims. In particular, each of claims **40, 69, 70, 73 and 74** generally requires:

> *receiving from a device information regarding a payout amount… stored on the device, <u>wherein the payout amount has not been disclosed to a player</u>*, and

> *receiving from the player an indication, <u>after receiving the payout information and wherein the payout amount has not been disclosed to the player</u>, of an item that the player is interested in winning.*

Thus, in accordance with the present claims, the game outcomes **already exist** at the time the player indicates an item that he is interested in winning. In an attempt to support the obviousness rejection, the Examiner has read a cited portion of <u>Nguyen</u> (col. 6, lines 60-64) out of context and incorrectly. In particular, the cited portion reads:

> "Each of the prize selection tables 200 and 202 contains a number of prizes which a player may select as an award or pay-out when a certain outcome occurs during the course of a game being played on a gaming machine." (Col. 6, lines 60-64).

Appellants submit that this sentence does not teach <u>when</u> the player makes a selection; it is simply a description of the prize selection tables. In addition, it is clear from the disclosure of <u>Nguyen</u> that follows this citation that the player first selects a prize which <u>may be won</u> when a jackpot occurs (col. 6, lines 65), and that the player uses the selection tables to select prizes when <u>initiating</u> a game on the gaming machine (col. 7, lines 1-2). Furthermore, <u>Nguyen</u> specifically teaches that the prize selection process <u>usually begins before game play is initiated</u> (col. 7, lines 30-31). <u>Nguyen</u> makes it clear that the point of providing the prize tables to players is to

encourage game play and to add excitement (col. 7, lines 53-57). Consequently, <u>Nguyen</u> systems and methods are distinct from that recited by the pending claims.

C.2.   <u>No Evidence of Motivation to Combine Schneier and Nguyen</u>

Appellants respectfully submit that there is no teaching or suggestion in either <u>Schneier</u> or <u>Nguyen</u> (or otherwise supported by any evidence of record) to combine them. Although <u>Nguyen</u> mentions that the gaming machine may be a "lottery game", it does not provide any indication of why one skilled in the art would combine <u>Nguyen's</u> methodology with <u>Schneier's</u> off-line remote system. Appellants respectfully assert that one skilled in the art would <u>not</u> consider <u>Schneier's</u> system when attempting to solve the problem addressed by <u>Nguyen</u>, or vice-versa. Accordingly, the Examiner has failed to point out any teaching, suggestion or incentive in either <u>Schneier</u> or <u>Nguyen</u> for their combination.

D.   <u>Conclusion</u>

In view of the above remarks, we respectfully request review and reversal of all of the Section 112 and 103(a) rejections of the pending claims.

                                                Respectfully submitted,

<u>September 7, 2007</u>   <u>*/Stephan J. Filipek, Reg. No. 33,384/*</u>
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